

**REMARKS**

In the Final Office Action, the Examiner rejected claims 1, 7, 10-14, 17-18, 24, 27-31, and 34 -36 under 35 U.S.C. § 102(b) as anticipated by Pintsov et al., U.S. Patent No. 5,612,889. The Examiner also rejected claims 2-5, 8, 19-22, and 25 under 35 U.S.C. § 103(a) as obvious over Pintsov et al. in view of Ulvr et al., U.S. Patent No. 5,602,382. Furthermore, the Examiner rejected claims 6 and 23 under 35 U.S.C. § 103(a) as obvious over Pintsov et al. in view of Berson et al., U.S. Patent No. 6,039,257, and claims 9 and 26 under 35 U.S.C. § 103(a) as obvious over Pintsov et al. in view of Ulvr et al. and Berson et al. Finally, the Examiner rejected claims 15-16 and 32-33 under 35 U.S.C. § 103(a) as obvious over Pintsov et al. in view of Allum et al., U.S. Patent No. 5,420,403.

*Section 102(b) Rejections*

Regarding the section 102(b) rejection of claim 1 as anticipated by Pintsov et al., the Examiner has failed to state a *prima facie* case of anticipation. To establish a *prima facie* case of anticipation, each element recited in the patent claim must be found either explicitly or impliedly, in a single prior art reference. M.P.E.P. § 706.02. Because Pintsov et al. does not recite several elements of claim 1, as amended, the reference does not anticipate the claims and the rejection of claim 1 should be withdrawn.

For example, Pintsov et al. does not teach creating an identification file that uniquely corresponds to an identification code and a mailpiece, as recited in amended claim 1. Instead, the reference discloses a mailing identification file 122 that includes a list of addresses and identification codes. (Pintsov et al., col. 10, ll. 32-38.) Each

mailing identification file corresponds to a mailer's account number. (Pintsov et al., col. 10, ll. 19-30; Fig. 3.) The mailing identification file is used to calculate the total postage for sending mailpieces to all of the addresses listed in the mailing identification file. (Pintsov et al., col. 12, ll. 23-26.) Thus, the reference does not disclose a unique relationship between a mailpiece, an identification code, and an identification file, as recited in amended claim 1.

Pintsov et al. also does not disclose identifying a plurality of mailpieces in a mailpiece sorting system, each mailpiece having a unique identification code and a unique identification file, as recited in amended claim 1. In the Final Office Action, the Examiner stated that if a mailer submits only one item to be processed by the Pintsov et al. system, the mailing identification file would include only the record for the mailpiece. By this Amendment, Applicants have amended claim 1 to clarify that a plurality of mailpieces are identified in the claimed system, each mailpiece having a unique identification code and a unique identification file.

For at least the reasons given above, Pintsov et al. does not disclose several elements of amended claim 1, and the rejection of the claim should therefore be withdrawn. Independent claims 18, 35, and 36 contain similar recitation to claim 1 and were rejected for the same reasons as claim 1. Therefore, for at least the reasons given above with respect to claim 1, Pintsov et al. does not disclose several elements of claims 18, 35, and 36, as amended, and the rejections of those independent claims should be withdrawn.

Further, claims 7, 10-14, and 17 depend from claim 1 and claims 24, 27-31, and 34 depend from claim 18. These dependent claims cannot be anticipated by Pintsov et al. at least because the reference does not disclose several elements of the underlying independent claims. Therefore, the § 102(b) rejections of dependent claims 7, 10-14, 17, 24, 27-31, and 34 should be withdrawn.

Accordingly, Applicants contend that dependent claims 1, 7, 10-14, 17, 18, 24, 27-31, and 34-36 are allowable under 35 U.S.C. § 102(b).

#### *Section 103(a) Rejections*

The Examiner rejected claims 2-5, 8, 19-22, and 25 under 35 U.S.C. § 103(a) as obvious over Pintsov et al. in view of Ulvir et al., U.S. Patent No. 5,602, 382.

Furthermore, under 35 U.S.C. § 103(a), the Examiner rejected claims 6 and 23 as obvious over Pintsov et al. in view of Berson et al., U.S. Patent No. 6,039,257, and claims 9 and 26 as obvious over Pintsov et al. in view of Ulvir et al. and Berson et al. Finally, the Examiner rejected claims 15-16 and 32-33 under 35 U.S.C. § 103(a) as obvious over Pintsov et al. in view of Allum et al., U.S. Patent No. 5,420,403.

To establish a *prima facie* case of obviousness, (1) the prior art references must teach or suggest each of the claim limitations, (2) some suggestion or motivation must exist, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the references or combine the reference teachings, and (3) one must have a reasonable expectation of success. M.P.E.P. § 2143. In the Final Office Action, the Examiner failed to establish a *prima facie* case of obviousness at least because the cited references fail to teach or suggest all the claim elements.

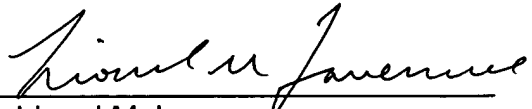
For example, at least for the reasons given above, Pintsov et al. does not teach or suggest creating an identification file that uniquely corresponds to an identification code and a mailpiece or identifying a plurality of mailpieces in a mailpiece sorting system, each mailpiece having a unique identification code and a unique identification file. All of rejected claims 2-6, 8-9, 15-16, 19-23, 25-26, and 32-33 recite these elements through their dependence upon amended claims. While Pintsov et al. fails to teach or suggest at least these claim elements, none of the secondary references cure these defects. Because the references, either alone or taken together, do not teach or suggest each of the elements of claims 2-6, 8-9, 15-16, 19-23, 25-26, and 32-33, the § 103(a) rejections of these claims should be withdrawn.

Accordingly, Applicants contend that claims 2-6, 8-9, 15-16, 19-23, 25-26, and 32-33 are allowable under 35 U.S.C. § 103(a).

In view of the foregoing remarks, Applicant respectfully requests the reconsideration and reexamination of this application and the timely allowance of the pending claims. Please grant any extensions of time required to enter this response and charge any additional required fees to our Deposit Account No. 06-0916.

Respectfully submitted,

FINNEGAN, HENDERSON, FARABOW,  
GARRETT & DUNNER, L.L.P.

By:   
Lionel M. Lavenue  
Reg. No. 46,859

Dated: April 9, 2003

FINNEGAN  
HENDERSON  
FARABOW  
GARRETT &  
DUNNER LLP

1300 I Street, NW  
Washington, DC 20005  
202.408.4000  
Fax 202.408.4400  
www.finnegan.com

**APPENDIX TO AMENDMENT SHOWING CHANGES MADE**

**IN THE CLAIMS:**

Please amend claims 1, 18, 35, and 36 follows:

1. (Twice Amended) A method of identifying a plurality of mailpieces [mailpiece] in a mailpiece sorting system, using [an] identification [code] codes corresponding to [an] identification [file] files, comprising the steps of:

marking one of the plurality of mailpieces [the mailpiece] with [the] an identification code that uniquely corresponds to the one mailpiece on the back of the mailpiece;

creating [the] an identification file uniquely corresponding to the identification code and the one mailpiece, where the identification file may be accessed from a plurality of nodes on the mailpiece sorting system; and

using the identification code to retrieve identification information from the corresponding identification file at a plurality of nodes on the mailpiece sorting system.

18. (Twice Amended) A system for identifying a plurality of mailpieces [mailpiece] in a mailpiece sorting system, using [an] identification [code] codes corresponding to [an] identification [file] files, comprising:

a marking component configured to mark one of the plurality of mailpieces [the mailpiece] with [the] an identification code that uniquely corresponds to the one mailpiece on the back of the one mailpiece;

FINNEGAN  
HENDERSON  
FARABOW  
GARRETT &  
DUNNER LLP

1300 I Street, NW  
Washington, DC 20005  
202.408.4000  
Fax 202.408.4400  
www.finnegan.com

a creating component configured to create [the] an identification file uniquely corresponding to the identification code and the one mailpiece, where the identification file may be accessed from a plurality of nodes on the mailpiece sorting system; and

a using component configured to use the identification code to retrieve identification information from the corresponding identification file at a plurality of nodes on the mailpiece sorting system.

35. (Twice Amended) A system for identifying a plurality of mailpieces [mailpiece] in a mailpiece sorting system, using [an] identification [code] codes corresponding to [an] identification [file] files, comprising:

means for marking one of the plurality of mailpieces [the mailpiece] with [the] an identification code that uniquely corresponds to the one mailpiece on the back of the one mailpiece;

means for creating [the] an identification file uniquely corresponding to the identification code and the one mailpiece, where the identification file may be accessed from a plurality of nodes on the mailpiece sorting system; and

means for using the identification code to retrieve identification information from the corresponding identification file at any node on the mailpiece sorting system.

36. (Twice Amended) A computer usable medium having computer readable code embodied therein for identifying a plurality of mailpieces [mailpiece] in a mailpiece sorting system, the computer readable code comprising:

a marking module configured to mark one of the plurality of mailpieces [the mailpiece] with [the] an identification code that uniquely corresponds to the one mailpiece on the back of the one mailpiece;

a creating module configured to create [the] an identification file uniquely corresponding to the identification code and the one mailpiece, where the identification file may be accessed from a plurality of nodes on the mailpiece sorting system; and

a using module configured to use the identification code to retrieve identification information from the corresponding identification file at any node on the mailpiece sorting system.

FINNEGAN  
HENDERSON  
FARABOW  
GARRETT &  
DUNNER LLP

1300 I Street, NW  
Washington, DC 20005  
202.408.4000  
Fax 202.408.4400  
www.finnegan.com